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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,204	12/22/1999	SATOSHI NISHIKAWA	862.3177	5888

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NEW YORK, NY 10112

EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 06/25/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,204

Applicant(s)

NISHIKAWA ET AL.

Examiner

Thierry L Pham

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. This action is responsive to the following communication: an Amendment filed on 5/13/04.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 7, 10, 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (U.S. 5749024), and in view of Hicks et al (U.S. 5481353).

Regarding claim 7, Young discloses a printing control apparatus (printer controller #100, Fig. 1, col. 4, lines 1-28) for controlling a printing device to output printing data onto a printing medium, comprising:

- (1) separation printing check means (checks via printer controller 100, fig. 1, col. 1, lines 65-67 to col. 2, lines 1-12 and col. 4, lines 45-60) for checking a separating separation printing setting, representing whether a predetermined medium (paper sheet, col. 2, lines 30-67) is additionally output over each page of the output printing data result (transparency, col. 2, lines 30-67); (2) printing order check means (printing order control system, col. 2, lines 30-67) for checking a printing order setting, set in advance, representing whether the printing data is output from a final page or from a first page (face-up, from page 1 to pages N, or face-down, from pages N to page 1) printing, col. 2, lines 30-67);
- (3) control means (output modules, col. 2, lines 1-10) for selectively controlling to (i) output each page of the printing data and then output the predetermined medium before a next printed page is output when the separation printing setting is set to additionally output the predetermined medium and the printing order setting is set to output (transparency than paper sheet if printing face-down, abstract and col. 2, lines 30-67 and col. 5, lines 5-17), and (ii) output the predetermined

Art Unit: 2624

medium before each page of the printing data is output when the separation printing setting is set to output the predetermined medium and the printing order setting is set to output the printing data from the final page (paper sheet than transparency if printing face-up, abstract and col. 2, lines 30-67 and col. 5, lines 5-17); and

(4) wherein the printing setting means sets the separation printing setting and the printing order setting with respect to individual print jobs (the printing can be set with respect to individual print jobs by interchanging an attachment of a different output module or printer controller 100 of fig. 1, col. 1, lines 65-67 to col. 2, lines 1-10 and col. 3, lines 35-42).

However, Young does not explicitly teach a printing setting means for setting, based on a user input to a graphical user interface, a separation printing setting and printing order setting for a print job.

Hicks, in the same field of endeavor for printers, teaches printing setting means for setting, based on a user input to a graphical user interface (figs. 2-6, cols. 7-10), a separation printing setting and printing order setting for a print job (figs. 2-6, cols. 7-10, and also see col. 3, lines 3-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Young as per teachings of Hicks because of a following reason: (1) user interface as shown in figs. 2-6 of Hicks allowing users to program a print job attributes/settings with ease and to increase operating efficiency.

Therefore, it would have been obvious to combine Young with Hicks to obtain the invention as specified in claim 7.

Regarding claim 10, Young further discloses the apparatus according to claim 7, wherein the printing medium is a transparent resin film, and the predetermined medium is paper (transparency and paper sheet, Abstract and col. 5, lines 10-15).

Regarding claims 1, 4: Claims 1, 4 are the method claims corresponding to the apparatus claims 7, 10 (respectively). The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 7, 10 above.

Claims 14-19 recites limitations that are similar and/or correspond to claim 1 as described above; therefore, the methods and/or apparatus claims recited (14-19) are inherent and included by the operation of the apparatus claim as described above (claim 1). Please see rejection basis/rationale as described in claim 1 above.

Claims 13, 20-22 recites limitations that are similar and corresponds to claim 1 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers have some type of computer readable memory medium for storing computer programs, hence claim 13 would be rejected using the same rationale as in claim 1.

4. Claims 2-3, 5-6, 8-9, 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Young and Hicks as described in claims 1 and/or 7 above, and in view of Ishizuka et al (US 5282050).

Regarding claims 8-9, Young does not explicitly disclose wherein the apparatus according to claim 7, further comprising: a saving state check means for checking whether the printing device is set to a saving state in which a page having no output data is not output; and saving function invalidating means for invalidating setting of the saving state when setting of additionally outputting the predetermined medium is detected by said separation printing check means and setting of the saving state is detected by said saving function check means.

Ishizuka, in the same field of endeavor for printing, discloses a saving state check means for checking whether the printing device is set to a saving state in which a page having no output data is not output (col. 5, lines 49-67); and saving function invalidating means (since Ishizuka's reference prohibits printing of blank page; therefore, Ishizuka also capable of invalidating of such settings, that is, reversed its settings) for invalidating setting of the saving state when setting of additionally outputting the predetermined medium is detected by said separation printing check means and setting of the saving state is detected by said saving function check means.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Young as per teachings of Ishizuka because of a following reason: (1) to

Art Unit: 2624

eliminate and/or reduce printing cost by “prohibit and/or prevent” printing of pages that contain no data or blank pages.

Therefore, it would have been obvious to combine Young with Ishizuka to obtain the invention as specified in claims 8-9.

Regarding claim 11, Young further discloses the apparatus according to claim 9, wherein the predetermined content is the same as a content printed on each page of the output result (print job data such as images, col. 3, lines 35-42).

Regarding claim 12, Young further discloses the apparatus according to claim 7, further comprising spool means for converting the predetermined data into another format and saving the converted data as a spool file (it is known in the art that print data are converted to a printer format/languages before printing, i.e., PDL, PCL, and/or raster data. Such conversion can be done by printer driver); and de-spooler means for mapping the spool file under control of said control means and supplying the mapped file to the printing device.

Regarding claims 2-3, 5-6: Claims 2-3, 5-6 are the method claims corresponding to the apparatus claims 8-9, 11-12 (respectively). The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 8-9, 11-12 above.

Response to Arguments

5. Applicant's arguments filed 5/13/04 have been fully considered but they are not persuasive.

Regarding claim 1, the applicants argued the prior art does not teach a printing setting means for setting, based on a user input to a graphical user interface, a separation printing setting and printing order setting for a print job. The examiner will note that Applicants are arguing subject matter not previously claimed in claim 1. Nowhere in previous claim 1 that applicants

recite the nature of "printing setting means for setting, based on a user input to a graphical user interface, a separation printing setting and printing order setting for a print job."

In addition, the applicants also argued the prior art (Ishizuka, 5282050) does not teach invalidating setting of a saving state when a setting of additional outputting a predetermined medium is detected in the separation printing check.

Ishizuka (col. 5, lines 49-67) teaches saving state check means for checking whether the printing device is set to a saving state in which a page having no output data is not output. Since Ishizuka teaches the print job with a page having no data is not printed; therefore, one of ordinary skill in the art would simply turn off the saving function (that is, print job having a page with no data is also being printed).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) U.S. 5124731 to Knodt, teaches an UI for setting up a print job with plurality of attribute options (figs. 7-17).

(2) U.S. 5442732 to Matysek, teaches an UI for setting up a print job with plurality of attribute options (figs. 4-5).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2624

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

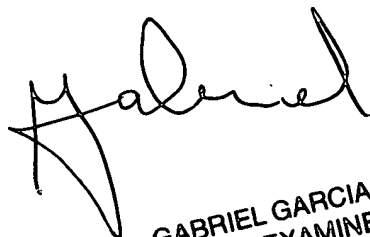
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

TP


GABRIEL GARCIA
PRIMARY EXAMINER